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| 09/978,524                    | 10/16/2001  | Gary H. Knauf        | S6765.US            | 5048             |
| 408                           | 7590        | 02/25/2005           | EXAMINER            |                  |
| LUEDEKA, NEELY & GRAHAM, P.C. |             |                      | TSOY, ELENA         |                  |
| P O BOX 1871                  |             |                      | ART UNJT            | PAPER NUMBER     |
| KNOXVILLE, TN 37901           |             |                      | 1762                |                  |

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|------------------------------|------------------------|---------------------|--|
|                              | 09/978,524             | KNAUF, GARY H.      |  |
| Examiner                     | <b>Art Unit</b>        |                     |  |
| Elena Tsoy                   | 1762                   |                     |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 11 August 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-21 is/are pending in the application.  
4a) Of the above claim(s) 13-21 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-12 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/31/2002.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_.

***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-12 in the reply filed on June 21, 2004 is acknowledged. The traversal is on the ground(s) that the claims are sufficiently related that their respective classes would be thoroughly cross-referenced. An examination of the Group II claims will require a search of the same prior art as an examination of the Group I. The restriction is improper because both criteria required by MPEP 803:1) the invention must be independent or distinct; and 2) there must be a serious burden on the Examiner are not met.

This is not found persuasive because both criteria required by MPEP 803 are met: the inventions of Group I and Group II are independent or distinct for the reasons of record set forth in Paragraph No. 2 of the Office Action mailed on September 24, 2003, and search and examination of independent and distinct inventions of Groups I and II would place serious burden on the Examiner since inventions of Groups I and II have acquired a separate status in the art as shown by their different classification, so that the search required for Group I would not require search for Groups II.

The requirement is still deemed proper and is therefore made FINAL.

***Specification***

2. The disclosure is objected to because of the following informalities: The serial number of commonly assigned Application, which is incorporated in the specification by reference, should be entered on page 9, line 13.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 recites the limitation "the polymer film coating" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 6, 8, 10, 11, 13, 16, 18-20, 23, 25, 30, 33, 40-43 of U.S. Patent No. 6,656,401. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-12 of current application fully encompass claims of '401 because each of the first web and the second web of '401 (See claim 10, 11) has caliper of from about 0.5 mils to about 10 mils and a basis weight of from about 7 lbs/3,000 ft<sup>2</sup> to

about 125 lbs/3,000 ft<sup>2</sup>, which includes a lightweight web of current application having 0.5 mils to about 1.4 mils and a basis weight of from about 7 lbs/3,000 ft<sup>2</sup> to about 17 lbs/3,000 ft<sup>2</sup>, as defined in the specification as filed (See page 5, lines 3-6), and the second web of '401 may be interpreted as being a carrier web.

As to claims 3, 8, 9, lightweight webs having 0.5 mils to about 1.4 mils and a basis weight of from about 7 lbs/3,000 ft<sup>2</sup> to about 17 lbs/3,000 ft<sup>2</sup> would have claimed properties inherently.

#### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-4, 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Backwell (US 3,620,872) in view of Marrocco, III et al (US 5,646,231).

Backwell discloses a method for the preparation of a self-supporting assembly comprising: providing a reusable carrier (See column 1, lines 6-16) such as endless carrier or a reel-to-reel carrier web (See column 1, lines 39-40), applying to said carrier a coating of polymeric material by such methods as melt extrusion, aqueous dispersion coating, solvent-based lacquering and hot melt coating (See column 1, lines 47-49), the coating in itself being non self-supporting but being capable of subsequent separation from said carrier when the coating has become part of a self-supporting assembly (i.e. coating forms claimed lightweight web) (See

column 1, lines 17-22), applying to the coating of polymeric material an adhesion promotion layer (See column 1, line 21; column 2, lines 9, 45, 69), and applying to the adhesion promotion layer at least one further layer of polymeric material by e.g. an extrusion coating (claimed polymer film coating) (See column 1, lines 56-57; column 2, line 10), whereby forming a self-supporting assemble, and subsequently separating said assembly from said carrier (See column 1, lines 22-27). The layers of material to form the finished self-supporting assembly (i.e. both claimed lightweight web and the polymer film coating) may be of such polymers as polyethylene or polypropylene, ethylene-vinyl acetate copolymer or vinylidene chloride copolymers or regenerated cellulose film, paper, board, metal foil or other material to which it is desired to apply a coated finish (See column 1, lines 59-64). The coating of polymeric material may be of ethylene-vinyl acetate copolymer (See column 2, lines 45-47), polyethylene (See column 2, lines 10, 69-70).

The Examiner's Note: although the polymeric coating in Backwell is very thin and not self-supporting, one of ordinary skill in the art at would easily recognize that the polymeric coating could be made thicker so that it would be mechanically stronger and self-supporting (but still lighweighted) depending on intended use of a final product.

Backwell fails to teach that the coating of polymeric material is formed separately from the carrier web (Claim 1).

Marrocco, III et al teach that coatings may be formed by *any* of the *established techniques*, including but not limited to: coating from melt, solution or latex, or laminating **preformed** films (See column 21, lines 5-9). In other words, Marrocco, III et al teach that laminating preformed films is functionally equivalent to coating from melt, solution or latex.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used preformed coating of polymeric material in Backwell instead of forming the polymeric coating by melt extrusion, aqueous dispersion coating, solvent-based lacquering and hot melt coating since Marrocco, III et al teach that laminating preformed films is functionally equivalent to coating from melt, solution or latex, and the selection of any of these known coating techniques in Backwell would be within the level of ordinary skill in the art.

As to claims 3, 8, and 9, it is the Examiner's position that the method of Backwell in view of Marrocco, III et al can be used for treating *any* lightweight material that would require a support to be treated without deformation, including those of claims 3, 8, and 9.

As to claims 10, and 11, it is the Examiner's position that any web including lightweight web and heavyweight web can be used as long as they are capable of supporting a lightweight material that would require a support to be treated without deformation.

9. Claims 1-4, 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson (US 3,840,421) in view of Backwell (US 3,620,872), further in view of Marrocco, III et al (US 5,646,231).

Peterson a method for registration web processing (See column 1, lines 4-6) comprising applying an adhesive to a carrier belt 12 such as stainless steel (claimed metal foil) (See column 3, lines 10-11, 25-36), pressing a web 44 of stretchable vinyl material (See column 3, lines 49-61), which is difficult to treat without support, (claimed lightweight web) (See column 1, lines 18-25) into contact with the adhesive to insure a quick adhesion of the web 44 to the belt and to prevent slippage of the web 44 on the belt 12 (claimed polymer film coating of claim 2) (See column 5, lines 49-63), printing the web 44 with various colors (See column 4, lines 3-29, 53-

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59), applying a sheet of protective clear vinyl material 72 to the web 44 (See column 4, lines 59-65), and stripping the completed web 44 from the carrier belt 12 (See column 5, lines 23-63). The web 44 has a width which is narrower than the total width of belt 12 (See column 3, lines 62-65).

Peterson fails to teach that the protective clear vinyl material 72 is added to the web 44 by extrusion coating (Claim 1).

Marrocco, III et al teach that coatings may be formed either by laminating *preformed* films *or* right on a substrate from e.g. melt, solution or latex, powder (See column 21, lines 5-9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed a coating of protective clear vinyl material 72 right on printed vinyl layer in Peterson from e.g. melt, solution or latex, powder instead of laminating preformed sheet of protective clear vinyl material since Marrocco, III et al teach that coatings may be formed either right on a substrate from melt, solution or latex or by laminating *preformed* films.

Backwell teaches that a coating of vinyl material may be formed right on a printed vinyl material by extrusion (See examples 1-4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used extrusion coating to apply a coating of vinyl material to a web 44 in Peterson in view of Marrocco, III et al in view of Backwell teaches that a coating of vinyl material may be formed right on a printed vinyl material by extrusion.

As to claims 3, 8, 9, it is the Examiner's position that the method of Backwell in view of Marrocco, III et al can be used for treating *any* lightweight material that would require a support to be treated without deformation, including those of claims 3, 8 and 9.

As to claims 10, and 11, it is the Examiner's position that any web including lightweight web and heavyweight web can be used as long as they are capable of supporting a lightweight material that would require a support to be treated without deformation.

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Backwell (US 3,620,872) in view of Marrocco, III et al (US 5,646,231), further in view of Anderson (US 4,963,303).

Backwell in view of Marrocco, III et al is applied here for the same reasons as above. As was discussed above, Backwell teaches that the layers of material to form the finished self-supporting assembly (i.e. both claimed lightweight web and the polymer film coating) may be of such polymers as polyethylene or polypropylene, ethylene-vinyl acetate copolymer or vinylidene chloride copolymers or regenerated cellulose film, paper, board, metal foil or other material to which it is desired to apply a coated finish (See column 1, lines 59-64). Backwell/in view of Marrocco, III et al fails to teach that the other material includes nonwoven fabric.

Anderson teaches that metal plate or moving non-woven fabric backing can be used as a suitable support for applying a casting solution in certain applications (See column 3, lines 56-64).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a non-woven fabric backing as other material to which it is desired to apply a coated finish in Backwell/in view of Marrocco, III et al since Anderson teaches that metal plate or moving non-woven fabric backing can be used as a suitable support for applying a casting solution in certain applications.

It is held that the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious); *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 8 USPQ2d 1323 (Fed. Cir. 1988).

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Backwell (US 3,620,872) in view of Marrocco, III et al (US 5,646,231), further in view of Enlow et al (US 6,254,712).

Backwell in view of Marrocco, III et al is applied here for the same reasons as above. Backwell/in view of Marrocco, III et al fails to teach that instead of applying each layer of the at least one layer of polymeric material onto a traveling carrier sheet by extrusion, the least one layer of polymeric material are applied onto the traveling carrier sheet by co-extrusion.

Enlow et al teach that polymeric layers can be applied onto a traveling carrier sheet by co-extrusion instead of applying each layer by extrusion in series (See column 14, lines 1-7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied at least one layer of polymeric material onto the traveling carrier sheet in Backwell in view of Marrocco, III et al by co-extrusion instead of applying each layer of the at least one layer of polymeric material onto a traveling carrier sheet by extrusion since Enlow et al teach that polymeric layers can be applied onto a traveling carrier sheet by co-extrusion instead of applying each layer by extrusion in series.

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit 1762

February 24, 2005